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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,876	08/03/2006	Dietrich H. W. Gronemeyer	GRONEMEYER ET AL-2PCT	7387
25889	7590	08/26/2010	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			MILLER, CHERYL L	
			ART UNIT	PAPER NUMBER
			3738	
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			08/26/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/581,876

Applicant(s)

GRONEMEYER ET AL.

Examiner

CHERYL MILLER

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7-8, 12, and 14-18 is/are rejected.
- 7) ☒ Claim(s) 6, 9-11 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's amendment filed June 14, 2010 has overcome the previous 112 rejection and 102 rejections over Alt (US 6,767,360), Melzer (US 6,280,385), and Weber (2004/0158310). Applicant's amendment has not overcome the previous rejection of Weber (2004/0230290). No specific arguments were presented with regards to this prior art.

Claim Objections

Claim 1 is objected to because of the following informalities: The claim recites, "conductive layers of the two or multiple layers". This statement is a little confusing, however is permitted. It seems the applicant may have intended to claim "conductive *regions of each* of the two or multiple layers", or "wherein two layers of the two or multiple layers are conductive layers" however the claimed recitation is fine.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 7, 8, 12, and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Weber et al. (US 2004/0230290 A1, cited previously). Weber discloses a medical device comprising a deformable structural part (fig.1, 2) with an expandable framework structure (100), formed by a plurality of metallic struts (46, 48; configuration shown in fig.1, 2, or P0054, P0052)

connected with one another, the struts (46, 48) composed of two or multiple layers that are glued together (see fig.2 for example; conductive layers 22 and 30 glued with layer 26, P0036 or adhesive that bonds 26 to conductive layers, P0039), the layers having different electrical or magnetic properties (same or *different* materials for layers 22 and 30; P0040), the struts (46, 48) having interruptions in conductive layers (cut portions, step 38 creates interruptions in two layers 22, 30, see fig.1, 2) in each of the two layers (22, 30) such that closed current paths are avoided (P0024), the interruptions situated in different positions such that the first layer interruptions do not overlap the second layer interruptions (see fig.2, interruptions on layer 22 are spaced 180 degrees or less away from interruptions on layer 30; P0042). Weber discloses a continuous current path from one end to another (when connector struts 48 are all along one side all the way down the stent, current path extends from one end to another; struts 48 at any arrangement locations a, b, c, or d; P0053). Weber shows two conductive layers (22, 30) separated by an insulative layer (26), the layers positioned coaxially (see fig.1). The stent of figure 2 (or disclosed at P0054) has helical path segments that overlap one another (see attachment 1 provided with previous office action).

Claims 1 and 14-16 are rejected under 35 U.S.C. 102(c) as being anticipated by Weber et al. (US 2005/0033407 A1). Weber discloses a medical device comprising a deformable structural part (fig.3) with an expandable framework structure (300), formed by a plurality of metallic struts (302, 304) connected with one another, the struts (302, 304) composed of two or multiple layers that are glued together (see embodiment in fig.14 of the thickness of the struts showing five or more layers, conductive metal layers 656, 654 glued by cement or polymeric

layers 652 or the adhesive used to bond layer 652 to 656 and 654; P0050, P0088), the layers having different electrical or magnetic properties (different metals, P0050), the struts having interruptions in conductive layers (conductive layers of fig. 14 are 656 and 654; interruptions 655 and 653) in each of the two layers such that closed current paths are avoided (eliminate electrical loops, P0050, P0082), the interruptions situated in different positions such that the first layer interruptions do not overlap the second layer interruptions (see fig. 14, P0082). Weber shows two conductive layers (656, 654) separated by an insulative layer (652), the layers positioned coaxially (see fig. 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. (US 2004/0230290 A1, cited previously) in view of Unger (US 6,884,407 B1, cited previously). Weber discloses a method of MR imaging a medical implant comprising placing a stent compatible with MRI within the body such that MRI can be used without disruption of the image within the stent (P0004-P0006). Weber discloses an MRI method substantially as claimed, however is silent to the details of the method, including whether or not contrast agents are used. Unger teaches in the same field as MR imaging, the use of ferrite contrast agents for providing a sufficient image of tissue (metal oxides, iron oxides, col.3, lines 35-59) during the imaging process. Such contrast agents are known to be used during MRI procedures. It would have been

obvious to one having ordinary skill in the art at the time the invention was made to combine Unger's evidence of known specific contrast agents (ferrites) for MR imaging, with the MR imaging process of Weber in order to provide an image that distinguishes the tissue.

Allowable Subject Matter

Claims 6, 9-11, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stinson (US 2006/0116755 A1) discloses metal conductive fibers within insulative polymer layers, the spacing between the fibers may be considered interruptions that may be applicable to some of the claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHERYL MILLER whose telephone number is (571)272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cheryl Miller/
Examiner, Art Unit 3738

/Corrine M McDermott/
Supervisory Patent Examiner, Art Unit 3738